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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,655	07/07/2006	Susumu Takumai	YAMA-0134	5541

37013	7590	03/12/2010
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EXAMINER	
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ART UNIT	PAPER NUMBER
2614	

NOTIFICATION DATE	DELIVERY MODE
03/12/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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TECHNOLOGY CENTER 2800**

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In re Application of:	:	
TAKUMAI, SUSUMU et al	:	DECISION ON PETITION TO
Application Serial No.: 10/585,655	:	WITHDRAW RESTRICTION
Filed: July 07, 2006	:	REQUIREMENT UNDER
For: <b>SPEAKER SYSTEM</b>	:	37 CFR 1.144

This is a decision on the petition filed January 17, 2010, under 37 CFR § 1.181 requesting withdrawal of the restriction requirement issued by the examiner on April 03, 2009; traversed by applicants in a response filed July 03, 2009; and maintained by the examiner in an Office action dated September 16, 2009. The petition is treated under 37 CFR § 1.144.

An election of species requirement was mailed on April 03, 2009 apparently setting forth restriction between four species of invention. (It is noted that the examiner divided the species based upon claims rather than figures or disclosed embodiments.)

A response to the requirement was timely filed and received in the Patent and Trademark Office (PTO) on July 03, 2009, wherein applicants elected to prosecute the claims of Species directed to Figures 2A-2C with traverse and indicated all claims 1-13 read on the elected species. Applicants argued in the response "(1) this is an improper Species requirement and (2) it is incomplete to the extent that the examiner is requiring applicant to elect only a single claim under each of the generic claims. Indeed, applicants take an Official Notice that it is improper to require applicants to select between claims in a Species requirement. Note also that the examiner does not address claims 9 -13. Requiring an election of species based only on the claims is facially improper as the claims themselves are never species. See MPEP § 806.04(e). If the examiner meant to restrict between the illustrated embodiments, the examiner should properly issue species restriction based on the illustrated embodiments."

Applicants go on to argue in the response "As set forth in MPEP § 806.04(f), restriction based on species can be applied only if claims identified by the examiner are mutually exclusive. Different species are mutually exclusive if one claim recites a limitation that is found in the first species but not in a second, while a second claim recites a limitation found only in the second species and not in the first species. Here, claims 1-13 are not

mutually exclusive, because all of the features set forth in claims 1-13 are found in the embodiment of Figs. 2A-2C. “

Petitioner seeks relief by filing the instant petition requesting that the restriction requirement be withdrawn or modified.

### OPINION

Petitioner contends that the proposed species requirement of April 03, 2009 failed to properly set forth species as defined in MPEP 806.04(e). Further, the petitioner argues, “as explained in the first Election, restriction based on species can be applied only if claims identified by the examiner are mutually exclusive. See MPEP § 806.04(f). Different species are mutually exclusive if one claim recites a limitation that is found in the first species but not in a second, while a second claim recites a limitation found only in the second species and not in the first species.”

A review of the record finds that the application is filed under 35 USC 371 in which case 37 CFR 1.499 *Unity of invention during the national stage* is applicable in lieu of restriction practice pursuant to 37 CFRT 1.141 – 1.146. As stated in MPEP 1893.03(d), “When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.” The examiner, in making the lack of unity requirement first noted that the claims are directed to four species. The examiner went on to state the, “The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features ...”. The examiner then reproduced the limitations of claims 2, 3, and 4 with respect to independent claim 1 and then reproduced the limitations of claims 6, 7, 8, and 9 with respect to independent claim 5 as evidence of four different groups of unique special technical features.

Upon review of the claims as divided by the examiner, the four different “special technical features” defined by the examiner appear to all be linked to the same inventive concept. For instance, since claim 3 and claim 4 are both dependent upon claim 2, by default the inventive concept of claim 2 is not unique to claims 3 and 4 and thus equally applies to claims 3 and 4. The same goes for the four different “special technical features” examiner alleges are defined by claims 6-9 claim. Since claims 6-9 are all dependent upon claim 5, by default the inventive concept of claim 5 is not unique to claims 6-9 and thus equally applies to claims 6-9.

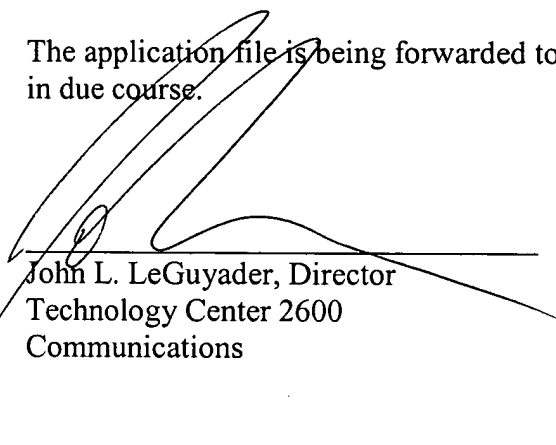
Furthermore, an election of species is proper if the species in question are mutually exclusive. Note MPEP 806.04(f) *Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. < Claims \*\* to different species \*\*>are mutually exclusive if< one claim recites limitations \*\*>disclosed for< a first species but not \* a second, while a second claim recites limitations disclosed only for the second species and not the first. This \*\*>may*

*also be expressed by saying that >to require restriction between claims limited to species, the claims \*\* must not overlap in scope<.* The examiner has not provided any explanation as to how the four different species are mutually exclusive. A review of claims 1-9 in light of what is disclosed (see disclosure of Figures 2A-2C) indicates the four alleged species may overlap in scope and are thus not mutually exclusive. Therefore the lack of unity requirement is improper.

### CONCLUSION

For the above stated reasons, the petition to withdraw the lack of unity requirement is **GRANTED**.

The application file is being forwarded to the examiner for a new and appropriate action, in due course.



John L. LeGuyader, Director  
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